

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD L. WILDE

Appeal No. 96-1747¹
Application 08/299,839

ON BRIEF

Before CALVERT, MEISTER and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 6, which is the only claim pending in this application.

¹Application for patent filed September 1, 1994. According to appellant, this application is a continuation-in-part of application serial no. 08/220,609, filed March 31, 1994, now U.S. Patent No. 5,431,368, issued July 11, 1995.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a form tie for securing a pair of concrete wall form structures together. The tie includes three saddle shaped portions sized and shaped so that the ties may be successively installed in the forms alternately inverted, so as to be alternately over and under reinforcing members located in the saddle shaped portions (specification, page 4). Claim 6, as amended after the final rejection, reads as follows:

6. A form tie for securing a pair of concrete wall form structures together in vertically upstanding, spaced apart relationship, said tie comprising:

 an elongate rod of constant diameter, being of sufficient length to span horizontally between the spaced apart form structure, said rod having a pair of longitudinally aligned opposing end portions having a common longitudinal axis, each end portion carrying means for securing said end portion to one of the pair of form structures; wherein

 at least one portion of the rod between the form structures is formed to be saddle shaped and is sized to accept at least one elongate reinforcing member having a horizontally directed axis perpendicular to the axis of the rod, the depth of the saddle shaped portion being sufficient to permit

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installation of ties horizontally space apart with the longitudinal axis thereof at a common elevation, with the saddle shaped portions of successive ties alternately opening upwardly and downwardly about the elongate reinforcing member; said form tie further comprising

at least one additional saddle shaped portion, said additional portion opening in opposite direction vertically from that of said saddle shaped portion, and sized to accept at least one elongate reinforcing member having a horizontal axis, the depth of the additional saddle shaped portion being sufficient to permit installation of a series of ties horizontally spaced apart with the longitudinal axes thereof at a common elevation, with the additional saddle shaped portions of successive ties alternately opening upwardly and downwardly about the elongate reinforcing member; wherein said tie comprises

three saddle shaped portions, two of which are spaced apart and opening in the same vertical direction, and the third of which opens in the opposite vertical direction and is located between said spaced apart portions.

The prior art reference of record relied upon by the examiner in rejecting the appealed claim is:

Vario	4,247,073	Jan. 27, 1981
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The following rejections are before us for review:

(1) Claim 6 stands rejected under 35 U.S.C. § 112, second

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paragraph, as being indefinite in that it fails to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

(2) Claim 6 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Vario.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No.

10) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 9) for the appellant's arguments thereagainst.²

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claim, to the applied prior art reference, and to the respective positions articulated by the appellant and the

² An amendment (Paper No. 11) and an attached affidavit filed on December 7, 1996, were denied entry (Paper Nos. 12 and 14) and, accordingly, have not been considered in our determination of the issues in this appeal.

examiner. The determinations we have made and the reasoning behind them are set forth below.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The examiner's reasons for rejecting the claim are found in the advisory action mailed May 5, 1995, and in the answer at page 3. The appellant does not contest this ground of rejection (brief, pages 2 and 3). Therefore, we are constrained to sustain this rejection.

The Rejection Under 35 U.S.C. § 102(b)

Claim 6 stands rejected as being anticipated by Vario.

The claim is directed to a form tie comprising an elongated rod of constant diameter having "three saddle shaped portions, two of which are spaced apart and opening in the same vertical

direction, and the third of which opens in the opposite vertical direction and is located between said two spaced apart portions." See, appellant's Figure 17.

The examiner argues that the three bent portions or kinks shown in the rod (10) in Figure 1 of Vario are "saddle shaped" and coplanar and, therefore, the language quoted above reads

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on the reference (answer, page 6). Appellant, on the other hand, argues that the examiner's "assumption" that the three bent portions or kinks are coplanar is not justified by Figure 1 or supported by any description thereof in the specification (brief, pages 5 and 6).

Anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or

possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 USPQ2d at 1749 (quoting In re Oelrich, 666 F.2d 578,

581, 212 USPQ 323, 326 (CCPA 1981).

With the above in mind, it is our view that Vario does not expressly or inherently describe that the bent or saddle shaped portions in the rod (10) are coplanar. In order for the bent or saddle shaped portions shown in Figure 1 of the reference to be coplanar, each of the illustrated four segments³ spanning the distance between stops (12) must be coplanar. We note that Vario describes Figure 1 as a "perspective view" (col. 2, line 5). As such, we cannot say with the necessary degree of certainty that the four segments all lie in the same plane. It may be that they do. It may also be true that they do not. The important point here is that we just don't know. We must resort to speculation in order to determine if Vario actually teaches that the bent or saddle shaped portions are coplanar and we cannot bottom a finding that Vario expressly or inherently describes each and every element of the claim on such speculation. Thus, the rejection under § 102 cannot be sustained.

³ The four segments are indicated by numerals 1, 2, 3 and 4 in the copy of Vario's Figure 1 attached as an "appendix" to appellant's brief.

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SUMMARY

The rejection of claim 6 under 35 U.S.C. § 112, second paragraph, is sustained.

The rejection of claim 6 under 35 U.S.C. § 102(b) is not sustained.

Since at least one rejection of the appealed claim has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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